

### **Remarks**

The Office Action dated December 4, 2009 has been carefully considered. Claims 11 and 12 were pending and have been amended along the lines discussed with Examiner Natalini during the personal interview conducted on March 16, 2010. Likewise, along the lines discussed with Examiner Natalini, new Claims 13-21 have been added to more thoroughly recite the inventive aspects of the present inventions. Among others things, Claims 12 and 16 are directed to a magnetron pressure gauge while Claims 13 and 17 are directed to a Penning pressure gauge. Among others things also, Claims 14, 18, and 20 are directed to an ultrahigh vacuum ranging from about  $10^{-12}$  to about  $10^{-6}$  millibar (mbar) while Claims 15, 19, and 21 are directed to an ultrahigh vacuum ranging from about  $10^{-8}$  to about  $10^{-6}$  millibar (mbar). Applicants respectfully request reconsideration and allowance of Claims 11-21

### ***Interview Summary***

At the outset, Applicants wish to express their sincere appreciation to Examiner Jeff Natalini for the professional and courteous personal interview afforded to Applicants' representative on March 16, 2010. During the personal interview, proposed amendments to Claims 11 and 12, a possibility of presenting new claims, and the art of record were discussed. In particular, it was discussed in some detail during the personal interview that amendments to Claims 11 and 12, would not only address their rejection under 35 U.S.C. 112, first paragraph, as proposed in the Office Action, but could also address their rejection under 35 U.S.C. 103(a) as proposed in the Office Action and as such, that such rejections of Claims 11 and 12, could be withdrawn.

***Claim Rejections 35 USC § 112***

In Paragraph 3 of the Office Action, Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully submit that the amendment of Claims 11 and 12 renders the rejection moot, which thus should be withdrawn.

***Claim Rejections 35 USC § 103***

In Paragraph 5 of the Office Action, Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denny (6701789) in view of Alexander (6870358) and Schneid et al. (4409482). Applicants respectfully submit that the amendment of Claims 11 and 12 renders the 35 U.S.C. 103(a) rejection moot, which thus should be withdrawn.

Additionally, Applicants respectfully submit that neither Denny (6701789) nor Alexander (6870358) nor Schneid et al. (4409482), whether taken alone or in combination, teach, suggest, disclose, and/or predict Applicants' claimed invention. It is also noted that neither Alexander (6870358) nor Schneid et al. (4409482) nor Alexander (6870358) combined with Schneid et al. (4409482) cure the deficiencies of Denny (6701789). Specifically, without more, it would not be obvious, expected, or predictable that one of ordinary skill in the art would be inspired or prompted to modify Denny (6701789) or Alexander (6870358) or Schneid et al. (4409482) to obtain either Applicants' claimed methods or Applicants' claimed devices.

Moreover, without the benefit of Applicants' disclosure, it would not be obvious, expected, or predictable that one of ordinary skill in the art would be inspired or prompted to modify Denny (6701789) or Alexander (6870358) or Schneid et al. (4409482), alone or in combination, to obtain either Applicants' claimed methods or Applicants' devices.

The fact that a claimed invention may employ known elements does not preclude patentability. It is the claimed combination of elements which is the proper basis for review. "Virtually all inventions are necessarily combinations of old elements." *Panduit* at 1575 (citing *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 220 USPQ 97, 99-100 (Fed. Cir. 1983)). Indeed, the Federal Circuit has stated (in regard to an obviousness-type invalidity challenge to an issued patent) that "[t]he notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, §103." *Panduit* at 1575. The standard of obviousness is not whether, in hindsight, someone would have combined elements to form the invention.

*W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983).

Applicants note that, as recently held by the Supreme Court in *KSR International Co. v. Teleflex Inc.*:

... a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since

uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. *KSR International Co. v. Teleflex Inc., et al.*, 550 U.S. 1, 14 (2007) (*emphasis added*).

The court in *KSR* also stated that when the art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be non-obvious. *Id.* at 12.

Even if the cited patents did disclose the features they currently lack, it is respectfully submitted that arriving at Applicants' claimed invention would not be expected, absent the benefit of hindsight using Applicants' explicit teachings. As also noted in *KSR International Co. v. Teleflex Inc., et al.*, 550 U.S. 1, 17 (2007), a factfinder, such as an Examiner, should:

be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See *Graham*, 383 U. S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to ““guard against slipping into the use of hindsight”” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))).

Applicants submit that the claimed combinations of features have “worked together in an unexpected and fruitful manner,” thereby supporting the conclusion that Applicants' claimed combinations were not obvious to those skilled in the art. *KSR*, at 12, citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966).

Accordingly, Applicants respectfully submit that the claims are neither anticipated nor rendered obvious by the cited patents and are, indeed, patentable over such patents and that the outstanding rejections should be withdrawn.

As noted above, new claims 13-21 have been added to more thoroughly recite the inventive aspects of the present inventions.

***Conclusion***

In light of the amendments and remarks presented herein, Applicants submit that the present application is in condition for allowance, and such action is respectfully requested. If, however, any issues remain unresolved, the Examiner is invited to telephone Applicants' counsel at the number provided below.

Respectfully submitted,

/Stanislav Antolin/

Stanislav Antolin  
Registration No. 34,979

SMITH MOORE LEATHERWOOD LLP  
P.O. Box 21927  
Greensboro, NC 27420  
(336) 378-5516  
stan.antolin@smithmoorelaw.com

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